

**REMARKS**

**Claims in Application.** Claim 36 has been amended. Accordingly, Claims 1, 5, 7-9, 11-12, 24-25 and 27-41 are active in this application. Reconsideration is respectfully requested.

**Examiner's Rejection of Claims Under 35 U.S.C. § 102(e).** The Examiner has maintained the rejection of Claims 1, 5, 7, 9, 24, 25 and 27-41 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,959,027 ("*Jakubowski*"). This rejection is traversed.

The claims of Applicant recite a polyurethane prepolymer prepared from a MDI diisocyanate wherein the MDI has a P,P'-isomer content of from 99 to 90 percent. In other words, 90 to 99 percent of the MDI is the P,P'-isomer. *Jakubowski* does not disclose use of a MDI wherein the P,P'-isomer content of the MDI is between 90 to 99 percent. *See*, for instance, lines 19-29 of column 5 wherein a 50:50 mixture of 4,4' and 2,4' isomers is disclosed. *See* further the Examples which are drawn to the use of ISONATE™ 50 MDI, likewise a 50:50 mixture. Applicant has demonstrated that films prepared from dispersions employing the claimed percentile of P,P'-isomer exhibit markedly higher tensile strength. Note the reported tensile strength of the films reported in Table I (Examples 1, 2 and 4 in contrast to Example 3). The claimed P,P'-isomer is not disclosed in *Jakubowski*.

The Examiner contends that "applicants' claimed P,P'-isomer content is met by *Jakubowski* because the processing of 4,4'-MDI inherently yields an insignificant quantity of other isomers; as a result it is reasonable to conclude that the P,P'-isomer content is slightly below 100 percent and meets the applicants' claimed percent values." (Paragraph 4 of Office Action.) The Examiner's rejection is based entirely on conjecture, is unsupported by the facts

and is contrary to the showings in Applicants' specification. Further, it is unclear what is meant by "processing of 4,4'-MDI" as well as "an insignificant quantity of other isomers".

*Jakubowski* does not disclose that the referenced 4,4'-MDI contains other isomers of MDI. There is no reason to conclude that the 4,4'-MDI of *Jakubowski* would contain other isomers. The Examiner's statement that the 4,4'-MDI of *Jakubowski* would contain other isomers is unsupported by the disclosure. Even if the 4,4'-MDI of *Jakubowski* contained a mixture of isomers, there is no reason to conclude that the quantity of such isomers would be between 1 to 10%.

The Examiner states that the 4,4'-MDI of *Jakubowski* would contain "an insignificant amount of other isomers", but fails to elaborate as to what constitutes an "insignificant amount" within the teachings of *Jakubowski*. In any event, the Examiner fails to ignore the limitations of the dependent claims, in particular the limitation of Claims 27 and 39 (about 98 to about 92 percent), Claims 28 and 40 (about 94 percent) and Claims 29 and 41 (about 98 percent). The Examiner's conclusion that such dependent claims are within the "insignificant" level allegedly taught by *Jakubowski* is unfounded.

In summary, the pending claims of Applicant are not anticipated by *Jakubowski*. The rejection should therefore be withdrawn.

**Examiner's Rejection of Claims Over WO 98/41552.** The Examiner has continued to maintain the rejection of Claims 1, 5, 7, 9, 24, 25 and 27-41 under 35 U.S.C. § 102(a) as being anticipated by WO 98/41552. This rejection is likewise traversed.

WO 98/41552 suffers from the same deficiencies as *Jakubowski*. In particular, WO 98/41552 is directed to a polyurethane/urea/thiourea latex. WO 98/41552 fails to disclose a polyurethane prepared from a formulation containing an MDI diisocyanate having a P,P'-isomer content from 99 to 90 percent. In fact, the diisocyanates exemplified in WO 98/41552 are the same diisocyanates taught in *Jakubowski*.

The Examiner indicates that "it is reasonable to conclude that the P,P'-isomer content is slightly below 100 percent" (paragraph 6 of Office Action). Why? The basis of the Examiner's statement is not apparent and is based on conjecture. Even assuming that the Examiner is correct (which he is not) and the P,P'-isomer content is "slightly below" 100 percent, there is no reason to conclude that the P,P'-isomer would be below 99 percent, much less 98 percent or 94 percent. Reconsideration is therefore requested.

Examiner's Rejection of Claims Over WO 98/41554. The Examiner has maintained the rejection of Claims 1, 5, 7, 9, 11, 24, 25 and 27-41 under 35 U.S.C. § 102(a) as being anticipated by WO 98/41554. This rejection is also traversed.

WO 98/41554 is not anticipated for the same reasons discussed above in relation to WO 98/41552. WO 98/41554, like WO 98/41552 and *Jakubowski*, does not disclose a polyurethane prepared from a formulation containing an MDI diisocyanate having a P,P'-isomer content from 99 to 90 percent. WO 98/41554 merely discloses a polyurethane prepared from a 4,4'-MDI. There is no reason to conclude that the P,P'-isomer content is "slightly below 100 percent" (paragraph 8 of Office Action), much less below the claimed limitations of 99 percent, 98 percent and 94 percent. Reconsideration is therefore requested.

**Examiner's Rejection of Claims Under 35 U.S.C. § 103(a).** The Examiner has maintained the rejection of Claims 8, 11 and 12 under 35 U.S.C. § 103(a) as being unpatentable over WO 98/41552 or WO 98/41554, each in view of U.S. Patent No. 6,389,602 ("*Alsaffar*"). Reconsideration is requested.

*Alsaffar* fails to cure the deficiencies of either WO 98/41552 or 98/41554. *Alsaffar* is directed to condoms and gloves made of films of polyurethanes. The MDI polyisocyanates claimed by Applicant are not disclosed in *Alsaffar*. The rejection is therefore traversed.

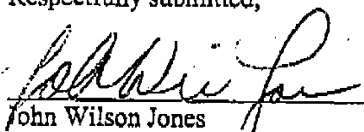
**Examiner's Rejection of Claim 36.** The Examiner has further rejected Claim 36 under the second paragraph of 35 U.S.C. § 112 as being indefinite. The amendment of Claim 36 obviates the need for further discussion of this rejection.

#### **CONCLUSIONS**

In view of the foregoing amendments and remarks, Applicant respectfully requests the Examiner to promptly issue a Notice of Allowance. The Examiner is invited to telephone the undersigned should it be deemed prudent to expedite examination of this application.

Respectfully submitted,

Dated: June 10, 2004

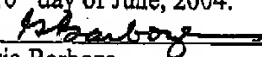
  
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**CERTIFICATE UNDER 37 CFR 1.6(d)**

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via facsimile, 703 872-9306, on this 10<sup>th</sup> day of June, 2004.

  
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